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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/526,622	03/16/2000	Reinhard H. Hohensee	BLD9-1999-0018US1	1965

23334   7590   12/31/2003

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EXAMINER
SHERKAT, AREZOO

ART UNIT	PAPER NUMBER
2131	

DATE MAILED: 12/31/2003   4

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/526,622	HOHENSEE ET AL.
	Examiner	**Art Unit**	
	Arezoo Sherkat	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _16 March 2000_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-23_ is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-23_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _16 March 2000_ is/are: a)☐ accepted or b)☒ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
   since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.
   37 CFR 1.78.

   a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific
   reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _2_.

4) ☐ Interview Summary (PTO-413) Paper No(s). _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☒ Other: *Formal Drawing Required.*

DETAILED ACTION

Claims 1-23 are presented for examination.

Drawings

New corrected drawings are required in this application because parts of drawings are not formal. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 18 recites the limitation "said data" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 21 recites the limitation "said first system" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1-10, 15-18, and 20-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Bahar, (U.S. Pub. No.: 2002/0019852 and Bahar hereinafter).

Regarding claim 1, Bahar discloses a system to notify remote output by an authenticated recipient to a designated party comprising:

an interface to a receiver (i.e., a recipient computer system) for receiving a file (i.e., email file) with authentication data (i.e., recipient's email address which is inherently included in the email file) from a remote system (i.e., sender computer system)(page 3, Par. 0024);

an input for receiving identification information (i.e., password or confidential code entry) from an authenticated recipient (i.e., a user with a user account)(Page 4, Par 0026);

a comparator for comparing if said identification information (i.e., the email address corresponding to identification information such as password, confidential access code, or other alternative means of identity verification presented upon access) from said authenticated recipient (i.e., a user with a user account) is matched to at least part of said authentication data in said file (i.e., the target party's email address in the email file ... in an email processing system, it is inherent to compare the logon information provided by the accessing party at the time of logging into his/her user account against the identification information corresponding to his/her user account recorded in the accessing party's computer registry to ensure security in ascertaining the identity of the accessing party)(Page 4, Par. 0029 and Page 7, Par. 0041);

an interface to an output for sending said file to an output device (i.e., opening the email file and viewing it by the accessing party) if said identification data from said authenticated recipient (i.e., the email address corresponding to his/her identification information recorded in the accessing party's computer registry which is inherent in an email processing system) is matched to at least part of said authentication data in said file (i.e., the target party's email address in the email file ... in an email processing system, it is inherent to compare the logon information provided by the accessing party at the time of logging into his/her user account against the identification information corresponding to his/her user account recorded in the accessing party's computer registry to ensure security in ascertaining the identity of the accessing party)(Page 4, Par. 0029 and Page 7, Par. 0041); and

an interface to transmitter for sending a notification of the output of said file to

said output device (i.e., confirmation of receipt of the email file by the accessing party)

to at least one designated party (i.e., sender computer system) if said identification data

from said authenticated recipient (i.e., the email address corresponding to his/her

identification information recorded in the accessing party's computer registry which is inherent in

an email processing system) is matched to at least part of said authentication data in said

file (i.e., the target party's email address in the email file ... in an email processing

system, it is inherent to compare the logon information provided by the accessing party

at the time of logging into his/her user account against the identification information

corresponding to his/her user account recorded in the accessing party's computer

registry to ensure security in ascertaining the identity of the accessing party)(Page 4,

Par. 0029 and Page 7, Par. 0041).

Regarding claim 2, Bahar discloses wherein said designated party is a party that

sends said file (i.e., email file) on remote system (Page 1, Par. 0002).

Regarding claim 3, Bahar discloses wherein said file (i.e., email file) further

comprises data indicating at least one designated party (i.e., the sending party's email

address)(Page 2, Par. 0012).

Regarding claim 4, Bahar discloses wherein said interface to transmitter (i.e.,

recipient computer) includes means for sending notification of the output of said file to

said output device (i.e., confirmation of receipt of the email file) to one designated party

(i.e., sender computer system) in said data (i.e., sender's email address) in said file (i.e.,

email file)(Page 2, Par. 0012 and Page 2, Par. 0014).

Regarding claims 5 and 6, Bahar discloses wherein said notification (i.e.,

confirmation of receipt) includes a location (i.e., access location), date, and time (i.e.,

date and time of the access event) said file (i.e., email file) is sent to said output device

(i.e., opened or displayed in the recipient computer system)(Page 7, Par. 0043).

Regarding claim 7, Bahar discloses a document retrieval system for accessing a

printed document and transmitting back, the identifying data of a party accessing or

making a copy of a document comprising:

means for transmitting (i.e., fifth executable software means) a document in data

form (i.e., confirmation of receipt notice) to a means for receiving (i.e., sending

computer) said document in data form (i.e., confirmation of receipt notice)(Page 2, Par.

0014);

means for receiving identifying data (i.e., discovering recipient's data which is

associated with recipient's email address) and transmitting said identifying data to said

means for receiving said document in data form (i.e., generating a confirmation of

receipt notice containing the discovered recipient data and transmitting it to a return

email address associated with sending party)(Page 2, Par. 0014); and

said means for receiving said document in data form (i.e., receiving computer) including means for printing said document (i.e., displaying email to the screen by double clicking or clicking on the email file) directly in response to said identifying data (i.e., after authenticating the recipient data with pre-recorded registered recipient info resident in the second computer)(Page 2, Par. 0014).

Regarding claim 8, Bahar discloses wherein said means for receiving (i.e., first executable software means for detecting a designated access event which is triggered by an accessing party and is generally associated with email retrieval from recipient email address) said document in data form includes means for sending to said means for transmitting a document in data form, said identifying data (i.e., receiving computer sending confirmation of receipt notice to a return email address associated with the sending party)(Page 2, Par. 0012 and Page 2, Par. 0014).

Regarding claim 9, Bahar discloses wherein said identifying data (i.e., log in and password) is in a predetermined format (i.e., pre-recorded registered recipient information), and said means for printing (i.e., viewing/displaying the email file) is directly responsive to said identifying data in said predetermined format (Page 2, Par. 0014 and Page 6, Par. 0038).

Regarding claim 10, Bahar discloses wherein said means for receiving (i.e., receiving computer) said document in data form (i.e., email file), includes a storage

device (i.e., hard disk drive) for storing said document and said document is accessed

from said storage device in response to said identifying data (i.e., logging into a user

account with a password or a confidential access code)(Page4, Par. 0028 and Par.

0029).

Regarding claims 15 and 16, Bahar discloses wherein said identifying data (i.e.,

confirmation of receipt notice) includes time and place of access data (Page 7, Par.

0043).

Regarding claim 17, Bahar discloses a method for retrieving a document and for

transmitting back, the identifying data of a party accessing or making a copy of a

document transmitted through a two way telecommunications system, comprising the

steps of:

transmitting a document from a systems device (i.e., first computer/sending

computer) through a two way telecommunications system (i.e., communication

network) to a presentation device (i.e., second computer/ receiving computer)(Page 2,

Par. 0012);

storing said document in said presentation device (i.e., receiving computer

system has means for storablly receiving email files on data storage means)(Page 4,

Par. 0028);

as a first step in accessing a copy of said document, inputting at said

presentation device (i.e., recipient computer), identifying data (i.e., user log in and

password) indicative of the identification of a party accessing the document (Page 4,

Par. 0029);

as a second step in accessing a copy of said document, and directly responsive

to said identifying data (i.e., discovering recipient data which is associated with

recipient's email address)(Page 2, Par. 0014), producing a print command (i.e., the

access event can occur upon opening the delivered email file subsequent to logging into

the user account)(Page 6, Par. 0029);

as a third step, producing a copy of said document (i.e., opening and/or viewing

email file)(Page 2, Par. 0014), in direct response to said print command, and

as a fourth step, producing a record of said the identifying data used to produce

said print command (i.e., triggering a designated access event and generating a

confirmation of receipt notice containing the discovered recipient data)(Page 2, Par.

0012), and transmitting said record (i.e., electronically transmitting the confirmation of

receipt notice)(Page 2, Par. 0012).

Regarding claim 18, Bahar discloses wherein said identifying data is in a

predetermined format (i.e., user's identity information would have to be pre-programmed

into the user terminal and directly associated with the user's personal security

code)(Page 7, Par. 0042) and said step of producing said print command includes the

step of producing said print command in direct response to receiving said data in said

predetermined format (i.e., discovery of user information would work to positively

identify the user of the terminal and trigger the access event)(Page 7, Par. 0042).

Regarding claim 20, Bahar discloses wherein said steps of producing a record and a transmitting said record includes the step of producing and transmitting a record of said identifying data (i.e., the steps resulting in transmitting the confirmation of receipt notice to a return email address associated with the sending party)(Page 2, Par 0012) with time of accessing data (i.e., confirmation of receipt notice includes information such as access location, phone number of access location, time, and date of access event)(Page 7, Par. 0043).

Regarding claim 21, Bahar discloses wherein said steps of producing a record (i.e., confirmation of receipt notice) and a transmitting said record includes the step of producing and transmitting a record of said identifying data with place of access data, to said first system (Page 2, Par. 0012 and Page 7, Par. 0043).

Regarding claim 22, Bahar discloses a computer readable media comprising programming instructions performing the method of retrieving a document and for transmitting back, the identifying data of a party accessing or making a copy of a document transmitted through a two-way telecommunications system comprising the programming instructions of:

transmitting a document from a system (i.e., first computer/sending computer) through a two-way telecommunications system (i.e., communication network) to a

presentation device (i.e., second computer/ receiving computer)(Page 2, Par. 0012 and Page 3, Par. 0022);

storing said document in said presentation device (i.e., receiving computer system has means for storably receiving email files on data storage means)(Page 4, Par. 0028);

as a first step in accessing a copy of said document, inputting at said presentation device (i.e., recipient computer), identifying data (i.e., user log in and password) indicative of the identification of a party accessing the document (Page 4., Par. 0029);

as a second step in accessing a copy of said document, and directly responsive to said identifying data (i.e., discovering recipient data which is associated with recipient's email address)(Page 2, Par. 0014), producing a print command (i.e., double-clicking the email file to view it)(Page 6, Par. 0029);

as a third step, producing a copy of said document (i.e., opening and/or viewing email file)(Page 2, Par. 0014), in direct response to said print command, and

as a fourth step, producing a record of said the identifying data used to produce said print command (i.e., triggering a designated access event and generating a confirmation of receipt notice containing the discovered recipient data)(Page 2, Par. 0012), and transmitting said record (i.e., electronically transmitting the confirmation of receipt notice)(Page 2, Par. 0012).

Regarding claim 23, Bahar discloses a computer program comprising

programming instructions for the operation of a document retrieval system for accessing

a printed document and transmitting back, the identifying data of a party accessing or

making a copy of a document transmitted through a two way telecommunications

system, comprising the programming instructions of:

transmitting a document in data form through said two way telecommunications

system (i.e., electronically transmitting the confirmation of receipt notice) to a means for

receiving said document in data form (i.e., to a return email address associated with the

sending party)(Page 2, Par. 0012 and Page 2, Par. 0014); and

receiving identifying data (i.e., logging the user in after evaluating his/her

password or confidential access code) and printing said document directly in response

to said identifying data (i.e., opening the delivered email file)(Page 4, Par. 0029).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Bahar, (U.S. Pub. No.: 2002/0019852 and Bahar hereinafter) in view of DiGiorgio et

al., (U.S. Patent No.: 6,418,420 and DiGiorgio hereinafter).

The teachings of Bahar are discussed above.

Regarding claims 12-14, Bahar does not disclose a portable device for storing said identifying data wherein said portable device is a smart card or a Java Ring.

However, DiGiorgio discloses a portable device for storing said identifying data wherein said portable device is a smart card or a Java Ring (i.e., a smart card, an integrated circuit card with magnetic strip that holds identification information or the Java Ring that includes a steel cylindrical housing and houses an integrated circuit that contains a microprocessor and a storage and also a ring portion that enable the user the whole device like an ordinary ring)(Col. 7, lines 17-19)(Col.7, lines 34-39)

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify the teachings of Bahar with the teachings of DiGiorgio to include a portable device for storing and identifying data wherein said portable device is a smart card or a Java Ring with the motivation to provide a portable device in a size, shape, and weight that is easily carried by the user and securely holds identification information used to confirm that a party is who the party purports to be (DiGiorgio, Col. 1, lines 53-62).

3. Claims 11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bahar, (U.S. Pub. No.: 2002/0019852 and Bahar hereinafter) and DiGiorgio et al., (U.S. Patent No. 6,418,420 and DiGiorgio hereinafter) in view of Bell, (U.S. Patent No. 6,600,902 and Bell hereinafter).

The teachings of Bahar and DiGiorgio are discussed above.

Regarding claims 11 and 19, Bahar and DiGiorgio does not expressly disclose wherein said identifying data is in a pre-determined Vcard format.

However, Bell discloses wherein said identifying data is in a pre-determined (i.e., standard)(Col. 9, line 61) Vcard format (i.e., a data object to be conveyed send, receive, transmit, or swap virtual business cards that may include a name, telephone and fax numbers, email address, and other type of information among multiple wireless stations by users involved in a business meeting or the like)(Col. 5, lines 18-30)(Col. 2, lines 47-50).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify the combined teachings of Bahar and DiGiorgio with the teachings of Bell to represent said identifying data in a pre-determined Vcard format with the motivation to provide for less tedious and repetitious entering of personal identification codes for individual links (Bell, Col. 3, lines 12-17).
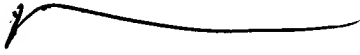
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arezoo Sherkat whose telephone number is (703) 305-8749. The examiner can normally be reached on 8:00-4:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (703) 305-9648. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3718.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is (703) 305-

3900.

THOMAS R. PEESO
PRIMARY EXAMINER

Arezoo Sherkat
Patent Examiner
Technology Center 2100
December 9, 2003